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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,435	03/31/2004	Sumit Malik	450103-04784.1	7789

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FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

LE, BRIAN Q

ART UNIT PAPER NUMBER

2623

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/815,435

Applicant(s)

MALIK ET AL.

Examiner

Brian Q. Le

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on April 21, 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25,32,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25,32,40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Response to Amendment and Arguments**

1. Applicant's amendment filed April 21, 2005, has been entered and made of record.
2. Applicant's arguments with regard to claims 1-25, 32, 40 and 41 have been fully considered, but are not considered persuasive because of the following reasons:

Regarding independent claims 1, 12, 18, 32, 40, and 41, the amendments were made by the Applicant created new problems in 35 U.S.C 112 along with the existing 35 U.S.C 112.

Please refer to the Office Action below for a clear discussion.

Thus, the rejections of all of the claims are maintained.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-25, 32, 40 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding the independent claims 1, 12, 18, 32, 40, and 41, the new amended limitation "wherein said selecting a corresponding input segment from one of said plurality of master datasets is performed in such a manner that the arrangement of said plurality of output segments in said output dataset provides fingerprinting of said output dataset" created new subject matter and is not support in the specification specifically FIG. 3. This limitation

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contradicts the shown concept of producing an output dataset having a plurality of output segments is equal to the number of input segments.

Claims not specifically addressed depend from indefinite antecedent claims.

5. Claims 1, 12, 18, 32, 40, and 41 similarly recite, "wherein said selecting a corresponding input segment from one of said plurality of master datasets is performed in such a manner that the arrangement of said plurality of output segments in said output dataset provides fingerprinting of said output dataset". Considering these facts and that the Court in *National Recovery Technologies, Inc. v. Magnetic Separation Systems, Inc.*, 166 F.3d 1190, 49 U.S.P.Q.2nd 1671 (Fed. Cir. 1999), summary judgment of invalidity for non-enablement affirmed in a mechanical case because the claims were broader than the enablement taught in the written description of the application, the claim is not enabled by the original disclosure.

6. Claims 1-25, 32, 40 and 41 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Regarding the independent claims 1, 12, 18, 32, 40, and 41, the concept of producing an output dataset having a plurality of output segments is equal to the number of input segments as supported in FIG. 3 of the specification is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claims not specifically addressed depend from indefinite antecedent claims.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-25, 32, 40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims 1, 12, 18, 32, 40, and 41 recite, "wherein said selecting a corresponding input segment from one of said plurality of master datasets is performed in such a manner that the arrangement of said plurality of output segments in said output dataset provides fingerprinting of said output dataset" are not well written so that one skill in the art can understand clearly. Appropriate corrections are required.

Thus, the rejections of all of the claims are maintained.

#### ***Claim Objections***

9. Claims 1-25, 32, 40 and 41 s are objected to because these claims are very difficult to understand due to the use of confusing language especially independent claims 1, 12, 18, 32, 40 and 41. Appropriate correction is required. The Examiner is unable to find the appropriate art to further reject the application due to many 35 U.S.C 112 issues.

#### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

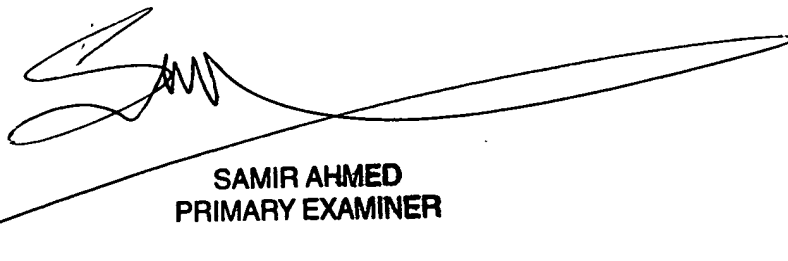
**Contact Information**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q Le whose telephone number is 571-272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 571-272-7414. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

BL  
August 7, 2005



**SAMIR AHMED  
PRIMARY EXAMINER**